

### REMARKS

Claims 1-2, 4-5, 19, 21, 23-24 and 38-40 are rejected as being obvious over Tokin in view of Parker.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggests the desirability of the modification. Tokin and Parker fail to suggest any motivation for, or desirability of, the changes espoused. Here, hindsight is relied upon to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Hindsight reconstruction cannot be used to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

The Examiner states "It would have been obvious to one having ordinary skill in the art at the time the invention was made to include Parker's symbol defined reference into that of Tokin invention. By doing do, the system would be enhanced by capable of providing pointer for capable of defining the appearance to the particular pages in the PDF file."

It is respectfully submitted that this does not amount to a proper teaching or suggestion in the prior art and that the references have been brought together through the use of an impermissible amount of hindsight and the teaching of the present invention, and not the references themselves. The references themselves teach the respective uses of their respective arrangements for their respective purposes. The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

Also, in order to establish a prima facie case of obviousness, the prior art references must teach or suggest all the claim limitations. While applicant's take issue with the proposed combination, even if a person of ordinary skill in the art would find it obvious to combine the teachings of Tokin and

Parker, the claimed features still would not be met. Specifically, it is respectfully submitted that neither Tonkin or Parker either singularly or in combination, disclose or suggest:

a) attribute representations operatively coupled by selecting them for adding, deleting or modifying ordered media attribute of a page;

b) symbolic representations of ordered media attributes operatively coupled by selecting the symbolic representation for adding, deleting or modifying the ordered media attribute of that page;

c) ordered media attribute representations coupled with page representations which operative to symbolically represent one ordered media attributes on a page representation, and wherein the ordered media attribute representation is operatively coupled by selecting it for adding, deleting or modifying the ordered media attribute of that page;

d) providing operative coupling ordered media attributes for each of the pages for viewing and/or adding, deleting or modifying the ordered media attributes of the pages by selecting the representations coupled with the pages; or

e) operative coupling to an ordered media attributes operator interface available for each page for viewing and/or adding, deleting or modifying the ordered media attributes of the pages by selecting the page representation for the pages.

The Examiner points to Tonkin col. 8, lines 37-40, col. 6, lines 26-27 and col. 6, lines 52-55. These portions of Tonkin are described specifically with regard to Fig. 5E, which fails to show the claimed invention. Direction is pointed to Tonkin at column 13, lines 13-16: “Returning again to FIG. 4, in step 266 the user may elect to edit the document specification after having viewed the document images. In this case, processing proceeds to step 254 to display the main document editing window 310.” The main document editing window 310 referred to is in Fig. 5E, which fails to describe the claimed invention. As the Examiner notes, the Figures (8a-8e) in Tonkin which show multiple pages having ordered media attributes describe only the functionality of advancing back and forth through the pages to display the pages. This is not operative coupling for editing the attributes associated with those pages. In order to add, delete or modify the attributes shown in those figures, the user must “proceed to step 254 to display the main document editing window 310”.

Claims 3, 6-9, 11-12, 15-17, 25-28, 30-31 and 34-36 are rejected as being obvious over Tokin in view of Parker, and further in view of Hube.

As the Applicant's have demonstrated, a combination of Tokin and Parker et al. does not render the claimed invention obvious because of the lack of motivation in either of these references to make the combination and the additional claimed features which are not taught or suggested in either of the references. Claims which further depend on this combination are therefore not obvious.

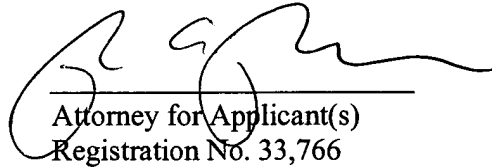
With regard to the term "pointer", the Examiner quotes from Parker: "The PDF file can define the appearance with a pointer to a page in the PDF file (see col. 7, lines 54-60)." The Examiner then explains: "The pointer reference personalized multiple pages in term of graphical objects. In an object based, the PDF file is made up of discrete page units that can be processed separately, and that the appearance of the object on a display output can be computed without knowledge of the appearance of a previous page or any other page. Thus, that page can be rendered independently of each other and in parallel. This in turn, supports shared objects and has an efficient structure for referencing and retrieving them. It not only contains graphical objects, but it also contains information describing the attributes and the placement of the graphical objects in the document." Applicant's cannot find such an explanation in Parker.

What Parker does disclose at col. 7, lines 57-60 is the following explanation: "The pointer can be expressed as a file name with a page number, or as a file name with a symbolic reference with a symbol defined in the PDF file."

In the present application, it is explained the "displayed pointer is manipulated over a particular thumbnail image". This is not a pointer expressed as a file name or symbol defined in the PDF file as described in Parker. The pointer referred to in Parker is not described or taught as a visual representation on a user interface for "pointing" to representations on the user interface.

In view of the above reasons, it is submitted that claims 1-40 are not obvious over the combined teachings of Tonkin, Parker and Hube and that the application is now in condition for allowance, and notice of the same is hereby respectfully requested.

Respectfully submitted,



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